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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,788	07/14/2003	Pay-Lun Ju	INMEP0108US	7803
43076 7590 08/27/2007 MARK D. SARALINO (GENERAL) RENNER, OTTO, BOISSELLE & SKLAR, LLP 1621 EUCLID AVENUE, NINETEENTH FLOOR CLEVELAND, OH 44115-2191			EXAMINER HAMZA, FARUK	
			ART UNIT 2155	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/619,788

Applicant(s)

JU, PAY-LUN

Examiner

Faruk Hamza

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-8 and 13-21 is/are pending in the application.
- 4a) Of the above claim(s) 1,2 and 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-8 and 13-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Response to Amendment***

1. This action is responsive to the amendment filed on June 22, 2007.  
Claims 1,2 and 9-12 have been canceled. Claims 3-8 and 13-17 have been amended. Claims 18-21 have been newly added.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 18 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claimed limitation "accessing network communication services... without independently registering the handheld device with a network service provider" is not supported by the specification.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984).

As to claim 19 and 21, also have the same deficiency of their base claim 18 and 20. Therefore, rejected for similar reasons.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to examiner what applicant meant by "the handheld device accesses the network communication services accessible by the IP appliance when the connectors are mated together and without independently registering the handheld device with a network service provider".

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology

Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by McZeal et al. (U.S. Patent Number 6,763,226) hereinafter referred as McZeal.

McZeal teaches the invention as claimed including world-wide-walkie-talkie, a high speed multifunction interstellar wireless computer/instant messenger communicator, Personal Digital Assistant (PDA), coupled with a resilient, roustb, VoIP data network and Internet server method (See abstract).

As to claim 18, McZeal teaches an Internet Protocol (IP) appliance, comprising:

an IP appliance, including:

an IP telephone (Fig. 11);

an IP appliance connector (Fig. 11);

at least one network interface to operationally connect to a network, the IP appliance having access to network communication services via the at least one network interface, the services including IP telephony services (Column 28, lines

5-37, Column 32, lines 12-50, Column 50, lines 28-48, Fig. 11,12,14 and 15); and

a housing that retains the IP telephone, the IP appliance connector, and the network interface (Column 28, lines 5-37, Column 32, lines 12-50, Column 50, lines 28-48, Fig. 11,12,14 and 15); and

a handheld device having a handheld device connector that physically mates with the IP appliance connector so that the handheld device and the IP appliance exchange signals (Column 28, lines 5-37, Column 32, lines 12-50, Column 50, lines 28-48, Fig. 11,12,14 and 15);

wherein the handheld device accesses the network communication services accessible by the IP appliance when the connectors are mated together and without independently registering the handheld device with a network service provider (Column 28, lines 5-37, Column 32, lines 12-50, Column 50, lines 28-48, Fig. 11,12,14 and 15).

As to claim 19, McZeal teaches the IP system according to claim 18, wherein the network communication services further includes Public Switched Telephone Network (PSTN) telecommunication services (Column 10, lines 8-25, Fig. 11,12,13,14 and 15).

As to claim 3, McZeal teaches the IP system according to claim 18, wherein a display of the handheld device displays information relating to an application executed on the IP appliance when the handheld device is

operationally connected thereto (Fig. 1).

As to claim 4, McZeal teaches the IP system according to claim 18, wherein the handheld device establishes a voice over IP (VoIP) call over a VoIP network through the IP appliance (abstract).

As to claim 5, McZeal teaches the IP system according to claim 19, wherein the handheld device establishes a PSTN call over a PSTN network through the IP appliance (Column 10, lines 8-25, Fig. 11,12,13,14 and 15).

As to claim 6, McZeal teaches the IP system according to claim 18, wherein the handheld device transmits data to and receives data from a remote device through the IP appliance (Fig. 11,12,13,14 and 15).

As to claim 7, McZeal teaches the IP appliance according to claim 18, wherein the handheld device can synchronize data between a personal computer connected to the network and the handheld device (Column 17, lines 57-Column 18, lines 59, Fig. 8).

As to claim 8, McZeal teaches the IP system according to claim 18, wherein the handheld device is a Personnel Data Assistant (PDA), a cell phone, a pager, an MP3 player or a combination thereof (Fig. ,11,12,13,14 and 15).

As to claim 20 McZeal teaches a method for using a handheld device connected to an Internet Protocol (IP) appliance, comprising:

establishing network communication services with an IP appliance, the services including IP telephony services (Column 28, lines 5-37, Column 32, lines 12-50, Column 50, lines 28-48, Fig. 11,12,14 and 15);

coupling a handheld device to the IP appliance (Column 28, lines 5-37, Column 32, lines 12-50, Column 50, lines 28-48, Fig. 11,12,14 and 15); and  
accessing the network communication services with the handheld device without independently registering the handheld device with a network service provider (Column 28, lines 5-37, Column 32, lines 12-50, Column 50, lines 28-48, Fig. 11,12,14 and 15).

As to claim 21, McZeal teaches The method according to claim 20, wherein the network communication services further includes Public Switched Telephone Network (PSTN) telecommunication services (Column 10, lines 8-25, Fig. 11,12,13,14 and 15).

As to claim 13, McZeal teaches the method according to claim 20, further including using a display of the handheld device to display information relating to an application executed on the IP appliance when the handheld device is



operationally connected thereto (Fig. 1).

As to claim 14, McZeal teaches the method according to claim 20, further including establishing a VoIP call over a VoIP network through the IP appliance using the handheld device (abstract).

As to claim 15, McZeal teaches the method according to claim 19, further including establishing a PSTN call over a PSTN network through the IP appliance using the handheld device (Column 10, lines 8-25, Fig. 11,12,13,14 and 15).

As to claim 16, McZeal teaches the method according to claim 20, further including transmitting and receiving data between a remote device and the handheld device through the IP appliance (Fig. 11,12,13,14 and 15).

As to claim 17, McZeal teaches the method according to claim 20, further including synchronizing data between a remote device and the handheld device through the IP appliance (Column 17, lines 57-Column 18, lines 59, Fig. 8).

4. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim,

other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context.

### ***Response to Arguments***

5. Applicant's arguments have been fully considered but they are not persuasive.

In the remarks applicant argues in substance that; A) McZeal does not teach a system where handheld device access the network communication services accessible to an IP appliance without independently registering with a network service provider.

In response to A) Claimed limitation is not supported by the specification. Therefore, not considered at this time.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is

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filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faruk Hamza whose telephone number is 571-272-7969. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached at 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

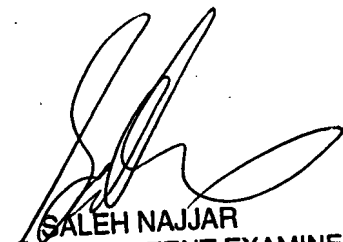
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Faruk Hamza

Patent Examiner

Group Art Unite 2155



SALEH NAJJAR  
SUPERVISORY PATENT EXAMINER